

**REMARKS**

Claims 1, 7-12, 14, 16, 20-21, 25-31, and 35-37 have been amended. Claims 1-37 are pending in the case. Further examination and reconsideration of pending claims 1-37 are respectfully requested.

**Section 102 Rejections**

Claims 1-3, 5-18, 20-29, 31-35, and 37 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0093648 to Nikoonahad et al. (hereinafter "Nikoonahad"). As will be set forth in more detail below, the § 102 rejections of claims 1-3, 5-18, 20-29, 31-35, and 37 are respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP § 2131. The cited art does not disclose all limitations of the currently pending claims, some distinctive limitations of which are set forth in more detail below.

**The cited art does not teach collecting light scattered from a specimen with a collection channel and detecting light collected by the collection channel with multiple detection channels.** Amended independent claim 1 recites in part: "collecting light scattered from the specimen with a collection channel; detecting light collected by the collection channel with multiple detection channels." Independent claims 14, 16, and 25 have been amended to recite similar limitations. Support for the amendments to these claims can be found in the Specification, for example, on page 11, line 23 to page 12, line 10, page 19, lines 18-26, and page 22, line 14 to page 23, line 27.

Nikoonahad discloses methods and systems for determining an implant characteristic and a presence of defects on a specimen. Nikoonahad, however, does not disclose collecting light scattered from a specimen with a collection channel and detecting light collected by the collection channel with multiple detection channels. For example, Nikoonahad states that "measurement device 34 may include a plurality of detectors 46...one of the detectors may be positioned with respect to a first light source to detect light scattered from the surface of the specimen." (Nikoonahad -- paragraph 0174). Nikoonahad also states that "Optical component

52 may also be coupled to detector 46, as shown in FIG. 4, and may be configured as, for example, "...a focusing lens." (Nikoonahad -- paragraph 0175). Therefore, Nikoonahad discloses detecting light collected by a focusing lens with one detector. However, Nikoonahad does not disclose detecting light collected by the focusing lens with more than one detector. In addition, Nikoonahad discloses detecting light scattered from a specimen with multiple detectors, as shown in Fig. 27 of Nikoonahad. However, Nikoonahad does not disclose that the multiple detectors detect light collected by the same collection channel. As such, Nikoonahad does not teach collecting light scattered from a specimen with a collection channel and detecting light collected by the collection channel with multiple detection channels, as recited in claims 1, 14, 16, and 25. Therefore, Nikoonahad does not teach all limitations of claims 1, 14, 16, and 25.

For at least the reasons set forth above, claims 1, 14, 16, and 25, as well as claims dependent therefrom, are not anticipated by the cited art. Accordingly, removal of the § 102 rejections of claims 1-3, 5-18, 20-29, 31-35, and 37 is respectfully requested.

#### Section 103(a) Rejections

Claims 4, 19, and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nikoonahad. As will be set forth in more detail below, the § 103 rejections of claims 4, 19, and 30 are respectfully traversed.

To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. *In re Bond*, 910 F.2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). The cited art does not teach or suggest all limitations of the currently pending claims, some distinctive limitations of which are set forth in more detail below.

The cited art does not teach, suggest, or provide motivation for collecting light scattered from a specimen with a collection channel and detecting light collected by the collection channel with multiple detection channels, as recited in claims 1, 16, and 25. For at least the reasons set forth above, Nikoonahad does not teach all limitations of claims 1, 16, and 25.

Nikoonahad does not suggest or provide motivation for all limitations of claims 1, 16, and 25. For example, Nikoonahad discloses detecting light specularly reflected from a specimen with two detectors, as shown in Fig. 7 of Nikoonahad. Therefore, since Nikoonahad discloses detecting specularly reflected light with two detectors, the light detected by the two detectors travels along the same collection path (i.e., the specular reflection path) and therefore may be collected by the same collection channel. However, although Nikoonahad discloses using two detectors to detect light specularly reflected from a specimen that may be collected by the same collection channel, Nikoonahad does not suggest or provide motivation for collecting light scattered from a specimen with a collection channel and detecting light collected by the collection channel with multiple detection channels. As such, Nikoonahad does not teach, suggest, or provide motivation for collecting light scattered from a specimen with a collection channel and detecting light collected by the collection channel with multiple detection channels, as recited in claims 1, 16, and 25. Therefore, Nikoonahad does not teach, suggest, or provide motivation for all limitations of claims 1, 16, and 25.

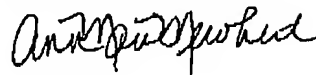
For at least the reasons stated above, claims 1, 16, and 25, as well as claims dependent therefrom, are patentably distinct over the cited art. Accordingly, removal of the § 103 rejections of claims 4, 19, and 30 is respectfully requested.

### **CONCLUSION**

This response constitutes a complete response to all issues raised in the Office Action mailed December 19, 2005. In addition, the art cited but not relied upon is not believed to be pertinent to the patentability of the present claims. In view of the remarks presented herein, Applicants assert that pending claims 1-37 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned earnestly requests a telephone conference.

The Commissioner is authorized to charge any fees, which may be required, or credit any overpayment, to deposit account number 50-3268/5589-06700.

Respectfully submitted,



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